

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
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Inventor(s): Paul McCORMAC)	Confirmation No. 2900
)	
Appln. No.: 10/539,625)	Group Art Unit: 1623
)	
Filed: January 3, 2006)	Examiner: Olson, E.
)	
Title: PROCESS FOR THE PREPARATION)	
OF OLIGONUCLEOTIDE)	

RESPONSE TO OFFICE ACTION

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Office Action dated March 2, 2009, reconsideration of this application is requested.

The Examiner has rejected the applicant's claims under 35 U.S.C. 103(a) as being unpatentable over Adams et al. in view of Sinha et al. (U.S. pre-grant publication 2006/0041114, corresponding to WO 2003/004512). However, it is respectfully submitted that Sinha et al. (now issued as U.S. Patent 7,501,505) does not qualify as prior art against the applicant in view of the provisions of Section 103(c)(1).

More specifically, the subject matter of the Sinha et al. reference and the presently claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely, Avecia Investments Limited.

While it is thought that the foregoing should be dispositive of Sinha et al. as applicable prior art, the following explanatory comments may be helpful to the Examiner, taking into account the several "Avecia" entities involved:

(1) Initially the Examiner will note that the Sinha et al. U.S. application as filed was assigned to Avecia Biotechnology Inc. and remains so.

(2) The present application as filed was assigned to Avecia Limited and subsequently assigned by Avecia Limited to Avecia Biotechnology Inc. Sinha et al. and the present application are, therefore, commonly assigned. However, it is recognized that the essential requirement under Section 103(c)(1) is common ownership at the time the invention was made. That this requirement is met is shown below.

(3) The Sinha et al. invention and the applicant's invention, when made, were part of Avecia's DNA Medicines business. This business operated two manufacturing and development facilities, one in Grangemouth, UK and one in Milford, MA, USA. The scientists in the UK were employed by Avecia Limited, and therefore ownership of inventions arising there vested in Avecia Limited under the provisions of UK patent law relating to employee inventions. The scientists in the U.S. were employed by Avecia Biotechnology Inc, and hence inventions arising there were to be assigned to Avecia Biotechnology Inc under their contracts of employment. The applicant's invention was made in Grangemouth, and hence filed by, and assigned to, Avecia Limited. Sinha et al. made their invention in the U.S., and hence their filing was made by, and assigned to, Avecia Biotechnology Inc. Subsequently, the Grangemouth facility was closed down, and business focused on the US facility. At the end of 2006, in connection with a reorganisation of Avecia's remaining UK businesses, the DNA Medicines related patents, including the instant application, were assigned to Avecia Biotechnology Inc.

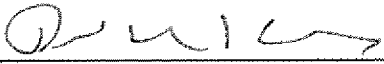
(4) In view of their relationship, technology developed by Avecia Limited was, of course, available to Avecia Biotechnology Inc. and vice versa, and the parties regularly cooperated with one another in sharing ideas, solving problems, etc.

(5) On the matter of ownership, it is noted that Avecia Limited was at the relevant time owned by Avecia UK Holdings Limited, which itself was owned by Avecia Investments Limited. Avecia Biotechnology Inc., on the other hand, was owned by Avecia Inc., which was owned by Avecia Holdings Inc., which was owned by Avecia Investments Limited. In summary, therefore, the ultimate common owner of the applicant's invention and the Sinha et al. invention, at the time the applicant's invention was made, was Avecia Investments Limited.

Consistent with the foregoing, the applicant respectfully submits that the Sinha et al. reference is not properly citable against the present invention. Furthermore, since Sinha et al. constitute an essential part of the Examiner's Section 103(a) rejection, the applicant submits that the rejection should be withdrawn. This

being the Examiner's only basis for rejection, allowance is thought to be in order and is requested.

Respectfully submitted,
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